

REMARKS

The above claim amendments are submitted along with the following remarks to be fully responsive to the outstanding Office Action mailed September 13, 2006. It is further submitted that this response is timely filed within the three month shortened statutory period. Reconsideration of all outstanding grounds of objection and rejection and allowance of the subject application are respectfully requested.

Claims 1-22 were rejected under 35 U.S.C. §102(f) because the Examiner indicated that the specification and claims appear to be similar and/or the same as that of 10/959,189 (“the ‘189 application”), however, the listed inventors are different in the two applications. Further, the Examiner indicated that claim 1 is identical in the two applications. First, Applicants note that the originally submitted claims 1 were not identical to each other in that the clause starting with “a fluid passageway” in each of these claims was different from that clause in the other claim (i.e., in the present application, the transfer chamber is indicated to be fluidly coupled to the reservoir channel, and in the ‘189 application, the transfer chamber is indicated to be fluidly coupled to the at least one cylinder tube). In any case, claim 1 of the present application has been amended to incorporate features of claims 2, 3, and 7 of the present application, thereby rendering the rejection under 35 U.S.C. §102(f) moot and/or overcome, as is explained in further detail below. Claims 2, 3, and 7 have also been cancelled, and claims that depended therefrom have been amended to change their corresponding dependencies.

Claim 1, as amended, provides for a penile prosthesis in which the pump has a cylinder deflation mode in which compression of a portion of the pump body moves a first poppet into sealing contact with a lip seal portion of a fluid passageway and also into sealing contact with a second poppet to thereby unseat the second poppet from the second valve seat. In this way, a gap is provided between the second poppet and the second valve seat to allow pressurized fluid to flow from at least one cylinder past the second poppet and into a bypass chamber through a bypass input channel. The first poppet is slideably moveable into contact with the lip seal to prevent fluid from moving between the pump bulb and the fluid passageway adjacent the second poppet. In this way, the prosthesis is resistant to unintentional inflation of the cylinders. In contrast, the

prosthesis of the '189 application provides for a pressurized reservoir that facilitates quicker inflation of the cylinder(s) when the valve body is squeezed because the squeezing of the valve body opens the pump valves to put its reservoir in direct communication with the cylinder(s). Further, in the cylinder deflation mode of the '189 application, the face seal portion of a first poppet is seated against the first valve seat, a lip seal portion is spaced from the first poppet, and a pump bulb is compressive for forcing pressurized fluid from the pump bulb into the fluid passageway to unseat the second poppet from the second valve seat to allow fluid to move past the second poppet into the reservoir. This compression of the pump bulb for moving fluid from the cylinder(s) into the reservoir in the '189 application is inherently different from the compression of the pump body of claims 1 and 22 of the present invention to move fluid from the cylinder(s) to the bypass chamber through the bypass input channel. At least for these reasons, claims 1 and 22 are believed to be patentable over the '189 application, along with dependent claims 4-6 and 8-21.

Claims 1-22 were provisionally rejected under 35 U.S.C. §101 as claiming the same invention as that of claims 1-11 of the '189 application. As discussed above, Applicant believes that the currently pending claims 1, 4-6, and 7-22 are not directed to the "same invention" (i.e., an invention drawn to identical subject matter) as that of the claims in the '189 application, at least in that the independent claims 1 and 22 have been amended and further for the reasons discussed above relative to the distinctions between the two inventions. Thus, applicant respectfully requests withdrawal of the double patenting rejection of the pending claims.

Claims 1-22 were also rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner indicated a failure to positively define the biasing directions of the first and second poppets and also a failure to define where along the fluid passageway the input and output channels are located, such as with respect to the first and second poppet valves. Independent claims 1 and 22 were amended to define the biasing direction of the second poppet as being away from the first valve seat, as illustrated throughout the figures, and because the first poppet is defined as being biased toward a first valve seat, the relationship between the biasing

directions has been clarified. In addition, independent claims 1 and 22 were amended to define the locations of the input and output channels relative to the fluid passageway, as is also illustrated throughout the figures. Thus, the rejections of the pending claims under 35 U.S.C. §112 have been overcome.

Accordingly, it is submitted that presently pending claims 1, 4-6, and 8-22 are currently in condition for allowance, a notice of which is earnestly solicited. The Examiner is invited to contact the undersigned, at the Examiner's convenience, should the Examiner have any questions regarding this communication or the present patent application.

The Commissioner is authorized to charge any additional fees or credit any overpayment to Kagan Binder deposit account No. 50-1775 and notify us of the same.

Respectfully Submitted,

Dated: 1/16/07

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